# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/932,289 | 08/17/2001 | Robert C. Booth | GIC-631 | 4758 |

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| EXAMINER |
|---|
| POND, ROBERT M |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3625 | |

DATE MAILED: 10/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 09/932,289 | BOOTH, ROBERT C. |
| | Examiner | Art Unit |
| | Robert M. Pond | 3625 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *17 August 2001*.

2a)☐ This action is **FINAL**.     2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *17 August 2001* is/are:  a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *11/28/01*.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

## DETAILED ACTION

### *Requirement for Information*

An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows: The provisional application is based primarily on formal equipment specifications pertaining to the Assignee's DAC-6000 (digital addressable control system), DANIS (digital addressable network interface server), DL (download server), KLS2000 (Key list server) and variations thereof that comprise the digital interactive network system (or platform). The Examiner is requesting documents in public use by the applicant and/or assignee General Instrument on or before 13 September 1999 pertaining to these or related products and software.  For example, sales or marketing literature or brochures, product data sheets, product specifications, user manuals, technical articles, white papers, doctorial thesis, master thesis, or other publicly available literature or published presentations or press releases that pertain to these products and software may have bearing on the patentability of the instant application.

Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

### *Specification*

1. The specification has not been checked to the extent necessary to determine the

presence of all possible minor errors.  Applicant's cooperation is requested in

correcting any errors of which applicant may become aware in the specification.

### *Claim Objections*

2. Claim10 is objected to because of the following informalities:  claim 10 depends

from claim 4 as a rule-based system of claim 1. Claim 10 refers to "The network

of claim 4. The Examiner assumes the Applicant is depending from the rule-

based system of claims 1 and 4.  Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as
> set forth in section 102 of this title, if the differences between the subject matter sought to be
> patented and the prior art are such that the subject matter as a whole would have been obvious at
> the time the invention was made to a person having ordinary skill in the art to which said subject
> matter pertains.  Patentability shall not be negatived by the manner in which the invention was
> made.

3. **Claims 1-6, 9, 10, 12-17, 19, and 20 are rejected under 35 USC 103(a) as**

**being unpatentable over Hendricks (US 5,682,195) in view of Aldrich (US**

**6,615,198).**

Hendricks teaches a system and method of configuring cable headend

components using a control computer and user interface (see at least abstract;

Fig. 2 (42); Fig. 3a (42); Fig. 4 (90, 91); Fig. 7 (90, 140, 142); col. 14, line 65

through col. 20, line 34).

- *initiating a user interface,* configuring at the headend by an operator

  programming changes to set top boxes (see at least Fig, 11 (42); col. 22,

  lines 39-63;

- *and enabling the user to select from among system components, service*

  *provider and corresponding service information,* Operator administers

  services by selecting channels (i.e. service providers providing sports,

  movies, magazines) ((see at least Fig, 11 (42); col. 12, lines 50-60; col.

  22, lines 39-63); picking and choosing programming for each transponder

  (see at least col. 10, lines 4-16).

- *systems; channels and transmission;* (see at least col. 8, line 25 through

  col. 9, line 23).

- *Machine-readable media/code:* Inherent in Hendricks are the structures

  necessary to provide machine-readable media and code. For example,

  Hendricks discloses a control CPU that controls the cable headend by

  executing computer logic; software (see at least Fig. 4 (90); col. 11, lines

  5-33; col. 17, lines 31-50).

- *Control computer:* interacts with components of the cable network.

- *Mapping:* signal mapped (see at least col. 7, lines 56-63).

Hendricks teaches all the above as noted under the 103(a) rejection and

teaches a) a computer controlled combiner with user interface to configure

headend components, and b) digital logic used to control the selection of

channels passed to a viewer, grouping of a plurality of sets of programs, and

blocking some viewers from receiving a grouping of programs (see at least col.

4, lines 10-23), but does not disclose specifics pertaining user/rules-based

representation. Aldrich teaches a system and method for creating solution tools

and using a solution tool by user through a graphical user interface to configure

components required for a system (see at least abstract; col. 1, line 5 through

col. 2, line 23). Aldrich teaches the need for such tools to efficiency and

inexpensively create solutions for requirements for systems and processes

communicating over the Internet (see at least col. 3, lines 21-34). Aldrich further

teaches a rules engine and rules-based logic used to help operators (i.e. users)

to associated components to options that can be selected to the questions that,

when executed, determine required components and required graphics for the

solutions based upon the selected options (see at least Fig. 2 (204, 206, 212);

col. 1, lines 41-58; col. 7, lines 23-45; col. 8, line 1 through co. 9, line 65). Please

note a displayed list of components resulting from the user interaction with the

rules-based logic (see at least Fig. 2 (232); Fig. 25; col. 8, line 53 through col. 9,

line 11; col. 23, lines 3-16). Therefore it would have been obvious to one of

ordinary skill in the art at time of the invention to modify the system and method

of Hendricks to implement rules-based logic control to configure equipment

components as taught by Aldrich, in order to provide the Hendricks user with and

easy-to-use rules-based logic interface, and thereby make the selection of cable headend components more efficient and less expensive.

Hendricks teaches all the above as noted under the 103(a) rejection and teaches a) mapping incoming signals from service providers, and b) using a computer to control headend component selection using digital logic, but does not disclose a first datastore for service providers, a second datastore of service delivery, and a third datastore for holding dynamic listing of selected components. Aldrich teaches all the above as noted under the 103(a) rejection and teaches a) holding a dynamic listing of selected components in a database, b)

4. **Claims 7, 8, and 18 are rejected under 35 USC 103(a) as being unpatentable over Hendricks (US 5,682,195) and Aldrich (US 6,615,198) as applied to claim 12.**

Hendricks and Aldrich teach all the above as noted under the 103(a) rejection and teach a) a subscriber's billing and account information, b) configuring a cable headend that passes service providers' channels to viewers, and c) displaying a component list report, but does not specifically teach a bill-of-material. One of ordinary skill in the art would recognize the value of the component list report as comprising components that have a cost associated with them and therefore would be useful in producing a bill-of-material. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the

system and method of Hendricks and Aldrich to use the component list report as

ascertained by one of ordinary skill in the art, in order to determine a cost to the

subscriber's billing and account information.

5. **Claim 11 is rejected under 35 USC 103(a) as being unpatentable over**
   **Hendricks (US 5,682,195) in view of Aldrich (US 6,615,198).**

   Hendricks teaches a system and method of configuring cable headend

   components using a control computer and user interface (see at least abstract;

   Fig. 2 (42); Fig. 3a (42); Fig. 4 (90, 91); Fig. 7 (90, 140, 142); col. 14, line 65

   through col. 20, line 34).

   - *initiating a user interface,* configuring at the headend by an operator

     programming changes to set top boxes (see at least Fig, 11 (42); col. 22,

     lines 39-63;

   - *and enabling the user to select from among system components, service*

     *provider and corresponding service information,* Operator administers

     services by selecting channels (i.e. service providers providing sports,

     movies, magazines) ((see at least Fig, 11 (42); col. 12, lines 50-60; col.

     22, lines 39-63); picking and choosing programming for each transponder

     (see at least col. 10, lines 4-16).

   - *systems; channels and transmission;* (see at least col. 8, line 25 through

     col. 9, line 23).

- *Machine-readable media/code:* Inherent in Hendricks are the structures necessary to provide machine-readable media and code. For example, Hendricks discloses a control CPU that controls the cable headend by executing computer logic; software (see at least Fig. 4 (90); col. 11, lines 5-33; col. 17, lines 31-50).

- *Control computer:* interacts with components of the cable network.

- *Mapping:* signal mapped (see at least col. 7, lines 56-63).

Hendricks teaches all the above as noted under the 103(a) rejection and teaches a) a computer controlled combiner with user interface to configure headend components, and b) digital logic used to control the selection of channels passed to a viewer, grouping of a plurality of sets of programs, and blocking some viewers from receiving a grouping of programs  (see at least col. 4, lines 10-23), but does not disclose specifics pertaining user/rules-based representation. Aldrich teaches a system and method for creating solution tools and using a solution tool by user through a graphical user interface to configure components required for a system (see at least abstract; col. 1, line 5 through col. 2, line 23). Aldrich teaches the need for such tools to efficiency and inexpensively create solutions for requirements for systems and processes communicating over the Internet (see at least col. 3, lines 21-34). Aldrich further teaches a rules engine and rules-based logic used to help operators (i.e. users) to associated components to options that can be selected to the questions that, when executed, determine required components and required graphics for the

solutions based upon the selected options (see at least Fig. 2 (204, 206, 212);

col. 1, lines 41-58; col. 7, lines 23-45; col. 8, line 1 through co. 9, line 65). Please

note a displayed list of components resulting from the user interaction with the

rules-based logic (see at least Fig. 2 (232); Fig. 25; col. 8, line 53 through col. 9,

line 11; col. 23, lines 3-16). Therefore it would have been obvious to one of

ordinary skill in the art at time of the invention to modify the system and method

of Hendricks to implement rules-based logic control to configure equipment

components as taught by Aldrich, in order to provide the Hendricks user with and

easy-to-use rules-based logic interface, and thereby make the selection of cable

headend components more efficient and less expensive.

Hendricks and Aldrich teach all the above as noted under the 103(a) rejection

and teach a) mapping incoming signals from service providers, b) using a

computer to control headend component selection using rules-based engine, c)

storing a dynamic listing of selected components in a database, d) storing

components data in a database and computer readable medium, and delivering

mapped transmission to viewers, but does not disclose a first datastore for

service providers, a second datastore of service delivery. One of ordinary skill in

the art at time of the invention would find it to be an obvious programming

practice to store service provider data associated with the service provider's

transmission data in order to maintain the relationship between transmission data

and source coming into the system with transmitted data and source being

delivered to the viewer. Therefore it would have been obvious to one or ordinary

skill in the art at time of the invention to modify the system and method of

Hendricks and Aldrich to store service provider data associated with the service

provider's transmission data and corresponding mapping data as ascertained by

one or ordinary skill in the art, in order to maintain the relationship between

transmission data and source coming into the headend system with transmitted

data and source being delivered to the viewer.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Cho, Joshua; "Operators rise to 'more channels' challenge," Cable World, 28 September 1998, v10n39p50, Dialog file 9 #01661384, 3pgs; teaches use of the Assignee's DAC6000 for headend programming.

- PR Newswire; "Shaw deploys General Instrument's multiple headend control system for 14 interactive digital headends," 8 September 1999, Dialog file 621 #02165637, 2pgs; teaches the Assignee implementing the DAC6000.
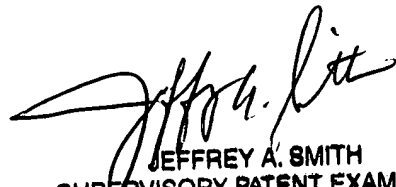
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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free). If you would like assistance from a USPTO Customer Service

Representative or access to the automated information system, call 800-786-

9199 (IN USA OR CANADA) or 571-272-1000.

Robert M. Pond
Primary Examiner
September 26, 2006

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